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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,092	11/20/2003	Herman Rodriguez	AUS920030853US1	9425
35525	7590	05/06/2005	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/718,092	RODRIGUEZ ET AL.
	Examiner Dennis Ruhl	Art Unit 3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

Applicant's response of 1/12/05 has been entered. Currently claims 1-25 are pending.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3,7,8,11-15,18-21,23-25, are rejected under 35 U.S.C. 102(b) as being anticipated by McNally et al. (6384850).

For claims 1,8,12,13,19-21, McNally discloses a system and method as claimed. McNally discloses a method where a customer of a restaurant can utilize a wireless device (i.e. PDA) to conduct a meal order. A hot spot location is inherent to the teaching of having wireless communication occur. For the wireless device to work with the restaurant's system a hot spot is required and is necessarily present. See column 13, line 62 to column 14, line 3 where the determination of whether or not any preferences are stored in the wireless device is disclosed. The menu that is generated is disclosed as being based on user preferences stored in the wireless device. The preferences can be "dietary needs" as claimed. The customized menu is generated by a server process as claimed because the system generates the menu based on the user preferences being present. The menu is then sent to the wireless device as claimed. See column 12, lines 1-5 and figure 7 for the disclosure of the placing of an order. For claim 13, the system of McNally has the recited providing means (the restaurant itself that provides the hot spot location), determining means (software that

checks for preferences), generating means (software that generates the menu based on the preferences), and sending means (hardware that allows the wireless communication to occur) as claimed. For claim 20, the claimed bus system, memory, and processing unit are all disclosed and inherent to the system of McNally. The system operates as claimed. For claim 21, McNally inherently has the claimed 1st, 2nd....5th instructions as claimed because McNally executes the same steps and all of the steps are performed by a computer.

For claims 23,24, the location of the hot spot has nothing to do functionally with the computer program product and is satisfied by McNally. The location of the hot spot does not further limit the claimed computer program product because reciting the location defines no further instructions to what is claimed in claim 21.

For claims 2,14, see column 10, lines 31-32 where the billing of the user is disclosed.

For claim 3, see column 3, lines 1-5 where the claimed limitation is disclosed.

For claims 7,25, if no preferences are stored by the user in the wireless device, the entire menu is downloaded to the wireless device. This allows the user to engage in "electronic dialog" as claimed because the user will use the wireless device to review the menu and place an order.

For claim 11, McNally discloses that a customer orders food via the wireless device. This satisfies what is claimed. The recitation of "for use by...." is reciting the intended use of the data that is sent, and is not a positive recitation of any kind of use of the data by a food analysis program.

For claim 15, the claimed sending means is the same sending means as recited in claim 13. The hardware that sends the menu to the wireless device can be used to send any type of data desired. Claim 15 is reciting a "means for sending" data where the intended use of the means for sending is an order identification type of data.

For claim 18, the claimed "entering mean" is interpreted to be the input mechanism that allows an electronic dialog to take place between the customer and the restaurant system.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 4,5,9,10,16,22, are rejected under 35 U.S.C. 103(a) as being unpatentable over McNally et al. (6384850). McNally discloses the invention substantially as claimed.

For claims 4,22, McNally does not disclose that in response to the order being placed, an order identification is sent to the wireless device. This can be interpreted more than one way. A first interpretation is that the order identification is an order number that is sent to the customer. A second interpretation is that the "order identification" is a listing of the items you just ordered so that the customer can verify the order is correct. A third interpretation is that the "order identification" is a message confirming that your order has been received. The order identification can also be a receipt that shows the total for your bill based on what you ordered. The term "order identification" (very broad term) is just interpreted to be some kind of data that is sent to the wireless device in response to the order being placed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to send the customer an order number, or a listing of the items you just ordered so that the customer can verify the order is correct, or a message confirming that your order has been received, or a receipt, so that the customer knows that the order has been placed and is being processed.

For claims 5,16, not disclosed is that the hot spot location is within the restaurant. It would have been very obvious to one of ordinary skill in the art at the time the invention was made to have the hot spot be within the restaurant so that customers can

sit down while viewing the menu. As an owner you would very much want to allow the customers to interact with the wireless menu system while they are in the restaurant.

For claim 9, not disclosed is that the user preferences include credit card information or diner club information. McNally does disclose that payment can be made via the wireless device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McNally to allow for payment preferences to also be stored in the wireless device so that the user can have a more efficient transaction by not having to specify the manner of payment each time they frequent the restaurant. The manner of payment (i.e. credit card) would be stored in the wireless device and the billing for the order would take place automatically.

For claim 10, not disclosed is the sending of receipt information (a receipt) for the food order. The recitation of "for use in at least one of" is a recitation directed to the intended use of the receipt and has been considered only to that extent. It is well known and old in the art to provide a receipt for a food order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to send a receipt to the wireless device for the food order. The entire food ordering process from looking at the menu to billing is disclosed as being conducted by the wireless device so it naturally follows that one of ordinary skill in the art would find it obvious to send a receipt to the wireless device.

6. Claims 6,17, are rejected under 35 U.S.C. 103(a) as being unpatentable over McNally et al. in view of Cogen (20020138350). McNally discloses the invention substantially as claimed.

For claims 6,17, not disclosed is that the restaurant has the hot spot location outside of the restaurant in a drive-through area. Cogen discloses a system where a user can interact with a restaurant by using a wireless device to place the order for food. A hot spot is provided for a drive through lane where the user can pick up their food while in their car. Drive through lanes are very old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the restaurant with a hot spot location at a drive through lane outside of the restaurant so that the advantages of the invention of McNally can be realized by drive through customers as well as customers that are eating inside the restaurant.

7. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection. The examiner would like to make one comment about the limitation argued for patentability. With respect to claim 7, if no preferences are present, then there is no generation of a customized menu, so what is the alleged allowable feature of claim 7? The limitation argued for patentability is not present in claim 7 and the examiner wanted to point this fact out to the applicant.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER